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TECHNOLOGY CENTER 2100

In re Application of:)
Munetake EBIHARA et al.)
Application No. 10/510,089)
Attorney Docket No. 09812.07530-00000)
Filed: June 20, 2005)
For: INFORMATION PROCESSING)
DEVICE LICENSE INFORMATION)
RECORDING MEDIUM,)
INFORMATION PROCESSING)
METHOD, AND COMPUTER)
PROGRAM)

**DECISION ON PETITION TO
WITHDRAW FINALITY OF
OFFICE ACTION UNDER 37 CFR
§ 1.181 AND WITHDRAW
RESTRICTION REQUIREMENT
UNDER 37 CFR §1.144**

This is a decision on the petition filed July 19, 2007 under 37 C.F.R. §1.181 and 37 C.F.R. §1.144 to withdraw finality of Office Action and to withdraw an outstanding restriction requirement.

The petition is **GRANTED**.

RELEVANT PROSECUTION HISTORY

October 19, 2006	A non-final Office action was mailed rejecting claims 1-19.
January 12, 2007	An amendment was filed canceling claims 1-19 and adding new claims 20-36. Claims 20-36 were pending.
April 04, 2007	A Final Office action was mailed including (1) election of claims 1-19 by original presentation and (2) withdrawal of claims 20-36 from consideration as non-elected due to the new claims 20-36 being directed to an invention that is independent or distinct from the invention originally claimed.

May 14, 2007 A telephonic interview was conducted (mailing date of May 21, 2007) indicating that the Final Office Action mailed April 4, 2007 was withdrawn and a new Office Action will be mailed.

May 21, 2007 Another Final Office Action was mailed (1) repeating the restriction requirement and (2) removing the rational to show the distinctness between the two alleged groups of inventions.

July 05, 2007 A Notice of Non-Compliant Amendment and an Interview Summary (PTO-413) were mailed indicating the Final Office Action mailed May 21, 2007 was withdrawn and all remaining claims are readable on the elected invention (claims 1-19).

July 19, 2007 The instant petition was filed seeking (1) to withdraw the Final Office Action mailed May 21, 2007 and (2) to withdraw the improper restriction requirement.

REGULATIONS AND PRACTICE

37 C.F.R. § 1.143 states:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 C.F.R. § 1.144 states:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

37 C.F.R. § 1.181 states:

- (a) Petition may be taken to the Commissioner:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding

which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 806.05(d) states in part:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, **are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.** To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary... [Emphasis added.]

MPEP § 821.01 states:

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse.

DECISION

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner.

37 C.F.R. § 1.144 states that the applicant may petition the Commissioner after a final requirement for the restriction has been made.

In the above-identified application, applicant filed several requests for reconsideration prior to the petition of July 19, 2007, in accordance with 37 C.F.R. § 1.143. Although the restriction was never made final in accordance with MPEP § 821.01, the initial restriction requirement was maintained in two or more subsequent communications. To expedite prosecution of this application, the Office action of July 05, 2007, which maintained the restriction requirement, is being treated as a Final restriction requirement.

The issue presented in the petition is whether the restriction based on original presentation under 37 C.F.R. § 1.145 is proper under the current regulations and practice.

A review of the first restriction based on original presentation mailed April 04, 2007 and the second restriction mailed May 21, 2007, it revolves that the examiner held the invention of newly added claims 20-36 and the invention of canceled claims 1-19 as being subcombinations disclosed as usable together in a single combination.

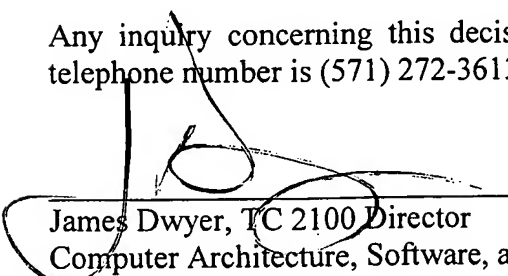
As stated in MPEP § 806.05(d), two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, **are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants**. A review of the new added claims 20-36 and the canceled claims 1-19 indicates that this two set of claims are substantially overlap in scope and are obvious variants. Therefore, the restriction based on original presentation is improper.

For the above reasons, the petition is **GRANTED**.

The restriction requirement is hereby **WITHDRAWN**. Further, since the restriction based on original presentation is improper, the Final Office Actions mailed April 04, 2007 and May 21, 2007 are herewith **WITHDRAWN**.

The application will be forwarded to the examiner for consideration on the merits of claims 20-36.

Any inquiry concerning this decision should be directed to Vincent N. Trans whose telephone number is (571) 272-3613



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